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EXAMINER
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WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

22

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/461,887  
Filing Date: December 15, 1999  
Appellant(s): DARTEY ET AL.

Paper No. 22

mailed oct  
date 4.4.02

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Timothy E. Tracy  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed November 21, 2002

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

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**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 1-19 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(9) Prior Art of Record**

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

EP 0 901 804

Cain et al.

March 17, 1999

CAPLUS Abstract 1994 :321,866 (JP 06024966) Kimura et al.

February 1, 1994

CPPLUS Abstract 1989:153130 (JP 63219357) Tanaka et al.

September 13, 1988

CAPLUS Abstract, 1986 :18914 (JP 60149367) Hohnen Oil Co.

August 6, 1985

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-19 are rejected under 35 U.S.C. 103(a)

These rejections are fully set forth in prior office action, paper No. 10.

**(11) Response to Argument**

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching suggestion and motivation are found both in the references and in the knowledge generally available to one of ordinary skill in the art. Particularly, Cain et al. teach the particular benefit of long chain alcohols including lowering the viscosity of fatty composition, and providing health benefit as fatty food ingredient. Kimura et al. and Hohnen

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show that long chain alcohols are known to be used with vegetable oil. Further, the combination of vegetable oil with long chain alcohols improves the absorption of the long chain alcohols. Therefore, one of ordinary skill in the art would be motivated to employ a well-known edible vegetable oil, soybean oil, to make a mixture with long chain alcohol as a healthy food product. Appellants improperly view the composition of Kimura et al. as solely for mice. Note, even though Kimura et al. use mice in the experiments, Kimura et al. do not limit the composition for mice only. Kimura et al. teach generally the improvement of absorption of the long chain alcohols.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Appellants argue that since Tanaka et al. require emulsifiers in a oil in water emulsion, the instant claim, which defined as "free of an emulsifier" is not obvious over Tanaka et al. Appellants further argue that in the composition of Cain et al., emulsifier is also required. First, Cain et al. never require an emulsifier in the mixture. See the claims in Cain et al. No emulsifier was mentioned by Cain (p.4, line 35 – p.5, line 9). If lecithin was considered as an emulsifier, lecithin is a component of the fat composition, not an ingredient added for the long chain alcohol/fat mixture. Question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art at the time

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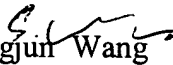
the invention was made; all disclosures of prior art, including unpreferred embodiments, must be considered. In re Lamberti and Konort (CCPA), 192 USPQ 278. Note Tanaka was cited to show that using long chain alcohol/oil to make an oil in water emulsion is known in the art. As clearly suggested by Kimura, in making a long chain alcohol/oil mixture does not require an emulsifier. Appellants improperly argue the claimed product does not contain emulsifier. In fact, the claims merely exclude the employment of emulsifier in the step of making the long chain alcohol/oil mixture, but does not exclude an emulsifier in the final products (emulsions). Further, one of ordinary skill in the art would know that a stable emulsion must contain at least three components: the dispersed phase, the dispersion medium and emulsifying agent (emulsifier). (See Remington Pharmaceutical Sciences, page 317). One of ordinary skill in the art would understand that the emulsifier employed by Tanaka is to form the emulsion, and would not be required in the step of making the long chain alcohol/oil mixture.

As to the argument about viscosity, it is noted that Cain teaches the employment of long chain alcohol herein for reducing the viscosity of edible oil products. See the claims. As discussed above, it is obvious to combine the vegetable oil and long chain alcohols. The combined mixture is expected to have low viscosity. The difference claimed herein and those disclosed by Cain et al. is in degree, not in kind. Such variation is obvious and is within the skill of artisan.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,


  
Shengjun Wang  
Examiner  
Art Unit 1617


February 24, 2003

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